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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,566	12/21/2001	Eric J. Horvitz	MS177851.01/MSFTP954US	4018
27195 7590 10/16/2008 AMIN, TUROCY & CALVIN, LLP 127 Public Square 57th Floor, Key Tower CLEVELAND, OH 44114				
EXAMINER BOUTAIL, ALINA A				
ART UNIT		PAPER NUMBER		
2443				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/036,566

Applicant(s)

HORVITZ ET AL.

Examiner

ALINA N. BOUTAH

Art Unit

2443

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 18, 19, 21, 23, 25, 27, 29, 31, 33, 35, 37, 41, 42, 46 and 69 is/are rejected.
- 7) ☒ Claim(s) 38 and 47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/17/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 1, 18, 19, 21, 23, 25, 27, 29, 31, 33, 35, 37- 38, 41, 42, 46-47 and 69.

DETAILED ACTION

Response to Amendment

This action is in response to Applicant's amendment filed August 4, 2008. Claims 1, 18, 19, 21, 23, 25, 27, 29, 31, 33, 35, 37- 38, 41, 42, 46-47 and 69 are pending in the present application.

Information Disclosure Statement

The information disclosure statement filed July 6, 2006 has been placed in the application file and considered.

It should be noted however, that the applicant has submitted an exorbitant amount of prior art on numerous PTO-1449's which, on initial consideration, do not all appear to have relevancy or pertinence to the instant invention as claimed. The applicant is requested in response to this office action to point out which of these numerous prior art are pertinent or relevant to the patentability of the invention as claimed in this instant application. It should be noted that it would be advantageous to the applicant to provide a concise explanation of why each of the prior art is being submitted and how it is understood to be relevant. "Concise explanations are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or where a large number of documents are submitted and applicant is aware that one or more are highly relevant to

patentability." (See MPEP 609 under subheading "A. CONTENT"; and also 37 CFR 1.98(b)(5)).

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 18, 19, 21, 23, 25, 27, 29, 31, 33, 35, 37, 41, 42, 46 and 69 are rejected under 35 U.S.C. 102(e) as being anticipated by Horvitz (US 6,988,132).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Horvitz teaches a computer-based system that facilitates optimizing utility of a communication, the system comprising:

an identifier that identifies one or more communication channels that facilitate maximizing the utility of the communication, the utility of the communication based on a cost and benefit of the communication to a contactor and a contactee, the cost and benefit of the communication is related to one or more preferences of the contactor and the contactee (abstract; col. 3, lines 22-31);

a communication group manager that manages a group of communicating parties to facilitate optimizing the utility of the communication along a communication channel identified by the identifier, membership of the group of communicating parties based at least in part of a reciprocated communication history between entities that comprise the group (col. 12, lines 14-38; col. 13, lines 9-20); and

a group wise communication coordinator that coordinates communication between a subset of the managed group of communicating parties to facilitate maximizing the utility of the communication (col. 18, lines 12-29).

Regarding claim 18, Horvitz teaches the system of claim 1, where the communication occurs between one or more contactors and one or more contactees and where the identifier comprises:

a processor;

a preference resolver that analyzes a contactee preference data and a contactor preference data and produces a resolved preference data (figure 2: 242);

a context analyzer that analyzes a contactee context data and a contactor context data and produces an analyzed context data (figure 2: 244);

a channel analyzer that analyzes one or more communication channels between a contactor and a contactee that analyzes on or more communication channels between a contactor and a contactee and produces a communication channel data (figure 2: 248); and

a communication establisher that establishes a communication between the contactor and the contactee based, at least in part on the resolved preference data that analyzed context data communicating party selection data and the communication channel data (figure 2: 248).

Regarding claim 19, Horvitz teaches the system of claim 1, the utility optimization based at least in part upon whether two or more communication parties are concurrently engaged in a related activity, or are likely to become concurrently engaged in a related activity (col. 20, lines 8-11).

Regarding claim 21, Horvitz teaches the system of claim 1, the utility optimization based at least in part upon whether two or more communicating parties are concurrently processing one or more related documents, or are likely to concurrently process one or more related documents (col. 20, lines 8-11).

Regarding claim 23, Horvitz teaches the system of claim 1, the utility optimization based at least in part upon whether two or more communicating parties are concurrently processing one or more related documents, or are likely to concurrently process one or more related documents (col. 20, lines 8-11).

Regarding claim 25, Horvitz teaches the system of claim 1, the utility optimization based at least in part upon whether two or more communication parties are concurrently viewing one or more related documents, or are likely to concurrently view one or more related documents (col. 20, lines 8-11).

Regarding claim 27, Horvitz teaches the system of claim 1, the utility optimization based at least in part upon whether two or more communicating parties are concurrently engaged in a shared project, or are likely to become concurrently engaged in a shared project (col. 28, lines 31-43).

Regarding claim 29, Horvitz teaches the system of claim 1, the utility optimization based at least in part upon whether two or more communicating parties are scheduled

to communicate within a predefined period of time, or have communicated within a pre-determined period of time (col. 2, lines 34-54).

Regarding claim 31, Horvitz teaches the system of claim 1, the utility optimization based at least in part upon whether two or more communicating parties are scheduled to meet within a pre-defined period of time, or have met within a pre-defined period of time (col. 2, lines 34-54).

Regarding claim 33, Horvitz teaches the system of claim 1, the utility optimization based at least in part upon whether a communicating party has engaged in one or more pre-defined activities of interest within a pre-defined period of time, or is likely to engage in one or more pre-defined activities of interest within a pre-defined period of time (col. 2, lines 34-54).

Regarding claim 35, Horvitz teaches the system of claim 1, the utility optimization based at least in part upon whether a communicating party has purchased one or more pre-defined of interest, or has registered an interest in one or more pre-defined items of interest (col. 2, lines 34-54).

Regarding claim 37, Horvitz teaches the system of claim 1, the utility optimization based at least in part upon the degree to which a communicating party is trusted by one or more other communicating parties (figure 10).

Regarding claim 41, Horvitz teaches the system of claim 39, where a utility function employed to compute the utility of the communication is a combination of functions that separately consider at least one of the cost and the benefit of the communication to at least one of the contactor and contactee (abstract).

Regarding claim 42, Horvitz teaches the system of claim 39, where a utility function employed to compute the utility of the communication is a multi-linear combination of one or more weighted terms associated with at least one of the contactor and contactee (col. 12, lines 13-37).

Regarding claim 46, Horvitz teaches the system of claim 1 where the group wise communication coordinator comprises: a group wise communication assembler that assembles the group communicating parties, and a group wise communication scheduler that schedules a time for the group communication that maximizes the utility of the communication (col. 2, lines 34-53).

Claim 69 has similar limitation as claim 1, therefore is rejected under the same rationale.

Allowable Subject Matter

Claims 38 and 47 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

It is noted that the column, line, and/or page number citations used in the prior art references as applied by the Examiner to the claimed invention are for the convenience of the Applicant to represent the relevant teachings of the prior art. The prior art references may contain further teachings and/or suggestions that may further distinguish the citations applied to the claims, therefore, the Applicant should consider the entirety of these prior art references during the process of responding to this Office Action. It is further noted that any alternative and non-preferred embodiments as taught and/or suggested within the prior art references also constitute prior art and the prior art references may be relied upon for all the teachings would have reasonably suggested to one of ordinary skill in the art. See MPEP 2123.

The prior art listed in the PT0-892 form included with this Office Action disclose methods, systems, and apparatus similar to those claimed and recited in the

specification. The Examiner has cited these references to evidence the level and/or knowledge of one of ordinary skill in the art at the time the invention was made, to provide support for universal facts and the technical reasoning for the rejections made in this Office Action including the Examiner's broadest reasonable interpretation of the claims as required by MPEP 2111 and to evidence the plain meaning of any terms not defined in the specification that are interpreted by the Examiner in accordance with MPEP 2111.01. The Applicant should consider these cited references when preparing a response to this Office Action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALINA N. BOUTAH whose telephone number is (571)272-3908. The examiner can normally be reached on Monday-Thursday (9:00 am - 5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia L.M. Dollinger can be reached on 571-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alina N Boutah/
Examiner, Art Unit 2443